

US.Pat.Ap.Nr: 09/911,700

Docket: 821-11US

**Remarks**

responsive to the (Final) Office Action dated 20 August 2004

1. We do not propose any amendments at this time.
2. We feel the PTO examiner has made a mistake in applying 35 USC 103 to the prior art in this case.

Reviewing our previous response, these are the underlying points:

(a) it is known in the prior art to cut pieces of glass by hand to decorative shapes, and to lay the pieces by hand on a glass base-pane, ready for firing.

(b) the prior art (Sellars) also discloses that it is known in the prior art to position pieces of glass on a pane of glass using a template.

Now, as mentioned, we might agree with the PTO that:-

(A) It might be obvious to modify the known cut-by-hand positioned-by-hand procedure, and use instead an NC machine to cut out the shaped pieces. In this modification of the known procedure, the NC-cut pieces would still be positioned by hand.

(B) Also, the skilled persons might have found it obvious to modify the known cut-by-hand position-the-pieces-by-hand procedure, and use instead a template to aid in the positioning of the hand-cut pieces. In this modification of the known procedure, the pieces are still cut by hand.

But it is our position that doing both things together, in a purposefully-coordinated unitary procedure, is inventive.

3. As we understand the PTO position as stated in the upper half of page 7 of the Final O/A, it is that having made the first obvious modification (A), the skilled person would then find it obvious to make the second modification (B).

In other words, the PTO alleges:-

(i) it would first be obvious to modify the known cut-by-hand positioned-by-hand procedure to a cut-by-machine positioned-by-hand procedure;

(ii) but, now starting from the just created modification, it would be also and separately then be obvious to make the other modification.

The PTO appears to have made a mistake. The PTO is basing its '103 rejection on the proposition that the skilled persons would find it obvious to make two modifications together, simply because they would find it obvious to make each modification separately. It is our view, in

the absence of any reasons why the skilled person would be moved to coordinate the two separate modifications, that there is no presumption whatever that they would find such a coordination of multiple modifications obvious.

As explained in our disclosure, cutting the pieces by NC machine makes the use of a template worthwhile, whereas using a template to aid in positioning hand-cut pieces is basically a waste of time, as explained. Thus, a major benefit arises from the fact of making both modifications together. This benefit is not realised at all by making either one of the modifications singly.

For the above reasons, we feel the '103 rejection of claim 1 should be withdrawn.

4. We offer the following further comments on the above.

- The procedure we identify as the cut-by-hand position-by-hand procedure is disclosed in the prior art.
- The cut-by-machine position-by-hand procedure is not disclosed in the prior art, but we have accepted that that procedure is an obvious modification to the disclosed procedure.
- The cut-by-hand position-by-template procedure is also not disclosed in the prior art, but we have accepted that that procedure is an obvious modification to the disclosed procedure.

To repeat, the cut-by-machine position-by-hand procedure is not disclosed in the prior art. The prior art cut-by-hand position-by-hand procedure has to be modified in order to get to the cut-by-machine position-by-hand procedure.

The PTO position, as stated at the top of page 7 of the O/A, is:

Applicant has already conceded that it would have been obvious to change from cutting the pieces by hand to cutting the pieces by machine. Therefore, all the limitations of claim 1 have been met except for that which provides for the pieces to be positioned on the base-plate using a template.

But of course, the fact that an obvious modification is obvious does not mean that the modified procedure can now be classed as having been disclosed in the prior art.

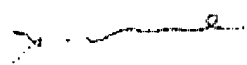
The PTO rejects claim 1 on the basis that the cut-by-machine position-by-hand procedure is disclosed in the prior art. This would appear to be a simple mistake, and we ask that the '103 rejection be withdrawn accordingly.

5. In a case where it is obvious to make a modification A to a prior art procedure, and obvious to make a modification B, it is not necessarily obvious to make both modifications A and B together. If the two modifications A and B have independent effects, it might be obvious to make them both, together. But where the two modifications have a synergistic advantageous

effect, which does not arise when either of the modifications is made on its own, but only arises when both modifications are made together, that is evidence that an invention has been made.

6. We note also that the PTO allegation, that the cut-by-machine position-by-hand procedure is actually disclosed in the prior art, appears for the first time in this Final O/A. The PTO made no mention of it in the first O/A. Thus, if the PTO decides to continue the rejection of claim 1 on the basis that the prior art discloses a cut-by-machine positioned-by-hand procedure, we ask that the "Final" status be withdrawn.

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Encls: (none)